



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,906	01/22/2002	Hendrik Antonius Hoogland	294-106PCT/US	7316

7590 06/07/2007
Ronald J Baron
Hoffman & Baron
6900 Jericho Turnpike
Syosset, NY 11791

EXAMINER

JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
----------	--------------

3728

MAIL DATE	DELIVERY MODE
-----------	---------------

06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/913,906

Applicant(s)

HOOGLAND ET AL.

Examiner

Jerrold Johnson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) 29-31 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers WO97/20315 published 05 June 1997 (as represented by US 6,029,811 which is the national stage of this application) in view of Sammet US 4,978,005 and further in view of Examiner's Official Notice.

Or, in the alternative, claims 19-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sammet US 4,978,005 in view of Heiligers WO97/20315 published 05 June 1997 (as represented by US 6,029,811 which is the national stage of this application) in view of Examiner's Official Notice.

In a nutshell, Sammet discloses indicia in the form of the title of a compact disc (data carrier) that is disposed on the jewel case (storage device) for that disc (plate-shaped data carrier). Sammet does not disclose the method through which the title is disposed on the case, but the title is, of course, specific to the data carrier within the case. Sammet does not disclose the purpose of the application of the title to the case. However, the invention of Sammet is for the purpose of providing identification to disc cases so as to make the storing and filing of the discs easier.

Heiligers discloses the process of in-mold labeling during the injection molding of cases like that of Sammet for the purpose of providing print (i.e. the title of Sammet) to the case.

Art Unit: 3728

The Examiner takes Official Notice that in-mold labeling has an art recognized benefit of providing labeling to packaging in a durable form that cannot be removed.

Accordingly, it would have been obvious to one of ordinary skill in the art to use the in-mold labeling method of Heiligers to apply the protective means (the title) to the case of Sammet so as to provide the title in a manner that ensures that the protective means cannot be removed from the case.

Again, with respect to the claim limitations of placing a second protective means that is different from the first protective means on a second storage device, and controlling the placement of the first and second protective means through a computer, the Examiner again takes Official Notice that the injection molding machines (of Heiligers) that are used to manufacture compact disc jewel cases are used for thousands of cases having many different titles. And, these machines, like most high volume manufacturing machines are, of course, computer controlled.

Additionally, the system of Sammet is based on many different compact disc titles having their title displayed on the case.

Accordingly, the claim limitations of placing a second protective means that is different from the first protective means on a second storage device, and controlling the placement of the first and second protective means through a computer would be the logical manner of placing the different titles of Sammet each onto a different compact disc case using the manufacturing methods of Heiligers.

In the alternative, it also would have been obvious to one of ordinary skill in the art to modify the reference of Heiligers which discloses the method of placing information of unknown type in the form of print on a compact disc case through in-mold labeling with the teachings of Sammet of placing the information in the form of the title of the compact disc on the disc case so as to provide the discs of Heiligers with the benefits to disc storage and filing that follow from the application of the teachings of Sammet.

Again, with respect to the claim limitations of placing a second protective means that is different from the first protective means on a second storage device, and controlling the placement of the first and second protective means through a computer, the Examiner again takes Official Notice that the injection molding machines (of Heiligers) that are used to manufacture compact disc jewel cases are used for thousands of cases having many different titles. And, these machines, like most high volume manufacturing machines are, of course, computer controlled.

Additionally, the system of Sammet is based on many different compact disc titles having their title displayed on the case.

Accordingly, the claim limitations of placing a second protective means that is different from the first protective means on a second storage device, and controlling the placement of the first and second protective means through a computer would be the logical manner of placing the different titles of Sammet each onto a different compact disc case using the manufacturing methods of Heiligers.

With respect to the dependent claims, the Examiner previously asserted that these are the known steps of in-mold labeling and the known case structures. This assertion was not contested.

Response to Arguments

Because of the new grounds for rejection the previous arguments are moot. However, the Examiner agrees that Butler WO/98/19305 does not describe the use of holograms that have information that is specific to the data of the data carrier that is disposed on the case, and the Examiner further agrees that it cannot be said that Butler describes in-mold labeling as the manner in which the holograms are disposed on his cases.

Having said this, should the Applicant pursue the non-elected claims drawn to the method of providing protective means in the form of a hologram, it is the belief of this Examiner that there will be difficulty on the part of the Applicant in showing patentability of those claims. Specifically the difficulty will be one of convincing the Examiner that one of ordinary skill in the art, when starting with the case of Butler that appears to disclose an adhesively applied hologram without any information that is specific to the compact disc stored within it, would not follow the path that has been taken in the use of holograms in such things as ID cards and credit/debit cards. That path being one of providing the hologram in a manner in which it cannot be removed from the card (as opposed to the previous use of hologram stickers), and including additional information with that hologram in the form of a bar code (as opposed to the use of a generic hologram). See for instance US 5,422,744, JP 41051643, US 5,141,212, US 6,164,548. As these claims are non-elected the references are provided as a courtesy. The Examiner uncovered these references while searching the claims under examination, and it should not be construed that the Examiner has completed the searching/examining this concept. However, the Examiner greatly appreciates the extent to which the Applicant pushed the ball forward by limiting the claims under examination. What goes around comes around.

Should the Applicant wish to discuss this case in a formal interview, the Applicant should contact the Examiner. This is not a "slam-dunk" examination. The issues regarding patentability of the presented claims are difficult to resolve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mickey Yu
Supervisory Patent Examiner
Group 3700